

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAANAN LIEBERMANN

Appeal 2007-0012
Application 09/603,247¹
Patent 5,982,853
Technology Center 2600

Decided: May 17, 2007

Before: FRED E. MCKELVEY, HOWARD B. BLANKENSHIP,
and ALLEN R. MACDONALD, *Administrative Patent Judges.*

MACDONALD, *Administrative Patent Judge.*

DECISION ON APPEAL

AFFIRMED

¹ Application filed June 23, 2000, seeking to reissue U.S. Patent 5,982,853 issued November 9, 1999, based on application 08/653,732, filed May 23, 1996, as a continuation-in-part of application 08/396,554, filed March 1, 1995, now abandoned. The real party in interest is the Appellant. (Br. 1).

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I. STATEMENT OF CASE

1. Appellant appeals under 35 U.S.C. § 134 from a final rejection of reissue claims 33-38 and 40-45 entered January 27, 2004.² We have jurisdiction under 35 U.S.C. § 6(b).

2. The only independent claim 33 under appeal reads as follows:

33. An electronic communications systems for the hearing impaired comprising:

a receiver for receiving spoken words and phrases;

means for translating said spoken words and phrases into a visual form which may be observed by a hearing impaired person;

said translating means including means for transforming said spoken words into equivalent signing content and then into textual material;

means for outputting said textual material for display on a device utilized by said hearing impaired person;

said device utilized by said hearing impaired person including means for receiving words and phrases from the hearing impaired person;

said transforming means converting said words and phrases from the hearing impaired person into a form which may be presented to a hearing person; and

means for outputting said converted words and phrases from said hearing impaired person.

² The Examiner has withdrawn the reissue recapture rejection of claims 34-45.

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3. A copy of Appellant's reissue claims 33-45 is set forth in the Claim Appendix of Appellant's Brief.

4. The Examiner rejected reissue claim 33 under 35 U.S.C. § 251 as being an improper recapture of surrendered subject matter (Supplemental Answer 3-5).

5. The prior art relied upon by the Examiner in rejecting the claims on appeal is:

King	US 4,903,290	Feb. 20, 1990
Wycherley	US 5,163,081	Nov. 10, 1992
Sakiyama	US 5,659,764	Aug. 19, 1997

6. The Examiner rejected reissue claims 33, 35-36, 38, 40, and 42-44 under 35 U.S.C. § 102(e) as being anticipated by Sakiyama (Supplemental Answer 5-7).

7. The Examiner rejected reissue claims 34, 37, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Sakiyama and Wycherley (Supplemental Answer 7-8).

8. The Examiner rejected reissue claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Sakiyama and King (Supplemental Answer 8).

9. Claims 1-32 are not rejected. The Examiner objected to claim 39 as depending on a rejected claim.

10. With respect to the rejection under 35 U.S.C. § 251, the panel affirms the decision of the Examiner.

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11. With respect to the rejections under 35 U.S.C. § 102(e) and § 103(a), the panel reverses the decision of the Examiner.

12. We use our authority under 37 C.F.R. § 41.50(b) to enter a new rejection of claims 34-43 and 45. The basis for this is set forth in detail *infra*.

II. ISSUES

The first issue before the Board is whether Appellant has established that the Examiner erred in rejecting claim 33 under 35 U.S.C. § 251 based on recapture.

The second issue before the Board is whether Appellant has established that the Examiner erred in rejecting 33, 35-36, 38, 40, and 42-44 under 35 U.S.C. § 102(e) and claims 34, 37, 41, and 45 under 35 U.S.C. § 103(a).

III. FINDINGS OF FACT

The following findings of fact are supported by a preponderance of the evidence.

A. *The Invention*

1. Appellant invented (U.S. Patent 5,982,853, Abstract):

An electronic communications system for the deaf includes a video apparatus for observing and digitizing the facial, body and hand and finger signing motions of a deaf person, an electronic translator for translating the digitized signing motions into words and phrases, and an

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electronic output for the words and phrases. The video apparatus desirably includes both a video camera and a video display which will display signing motions provided by translating spoken words of a hearing person into digitized images. The system may function as a translator by outputting the translated words and phrases as synthetic speech at the deaf person's location for another person at that location, and that person's speech may be picked up, translated, and displayed as signing motions on a display in the video apparatus.

B. Prosecution history of the original application

2. The patent sought to be reissued is based on Application 08/653,732, filed May 23, 1996 (which we refer to as the “original application” even though it is the second application in the sequence), as a continuation-in-part of Application 08/396,554, filed March 1, 1995, now abandoned.

3. As filed, the original application contained claims 1-32 including representative independent claim 1 which is reproduced below:

1. An electronic communications system for the deaf comprising:

(a) a video apparatus for observing and digitizing signing motions of a deaf person;

(b) means for translating said digitized signing motions into words and phrases;

(c) means for outputting said words and phrases in a comprehensible form to another person;

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(d) a receiver for receiving spoken words and phrases of another person and transmitting them;

(e) means for translating said spoken words and phrases into a visual form which may be observed by the deaf person; and

(f) means for outputting said visual form of said spoken words and phrases on said video apparatus for viewing by the deaf person.

4. On October 1, 1997, the Examiner entered a Non-Final Office Action ("Non-Final Action").

5. Claims 1-32 were rejected on various grounds.

6. Claims 22 and 23 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

7. Claims 12, 13, and 15-20 were rejected under 35 U.S.C. § 102(b) as being unpatentable over an article by Kurokawa (which is prior art under 35 U.S.C. § 102(b)).

8. Claims 1-11, 14, and 21-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurokawa and an article by Rogers (which is prior art under 35 U.S.C. § 102(b)).

9. Claims 1-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abramatic (U.S. 4,546,383) and Kurokawa. Abramatic is prior art under 35 U.S.C. § 102(b).

10. On April 1, 1998, Appellant filed a first Amendment ("the First Amendment") responding to the Examiner's First Office Action.

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(d) a receiver for receiving spoken words and phrases of another person and transmitting them;

(e) means for translating said spoken words and phrases into a visual form which may be observed by the deaf person; and

(f) means for outputting said visual form of said spoken words and phrases on said video apparatus for viewing by the deaf person.

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8. Claims 1-11, 14, and 21-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurokawa and an article by Rogers (which is prior art under 35 U.S.C. § 102(b)).

9. Claims 1-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abramatic (U.S. 4,546,383) and Kurokawa. Abramatic is prior art under 35 U.S.C. § 102(b).

10. On April 1, 1998, Appellant filed a first Amendment ("the First Amendment") responding to the Examiner's First Office Action.

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11. The First Amendment similarly amended independent claims 1, 12, and 26. Amended claim 1 is reproduced below (matter underlined added by the First Amendment and matter in [brackets] deleted by the First Amendment):

1. An electronic communications system for the deaf comprising:

(a) a video apparatus for visually observing [and digitizing] the images of facial and hand and finger signing motions of a deaf person and converting the observed motions into digital identifiers;

(b) means for translating [the digitized] said digital identifiers of said observed signing motions into words and phrases;

(c) means for outputting said words and phrases generated by the visual observation of said signing motions in a comprehensible form to another person;

(d) a receiver for receiving spoken words and phrases of another person and transmitting them;

(e) means for translating said spoken words and phrases into a visual form which may be observed by the deaf person; and

(f) means for outputting said visual form of said spoken words and phrases on said video apparatus for viewing by the deaf person.

12. After entry of the First Amendment, the application claims were 1-32.

13. In the First Amendment, Appellant presented arguments with respect to the patentability of amended claim 1.

14. Appellant's arguments (see below) addressed at least the following limitations of Appellant's amended claim 1:

- (1) visually observing the images of facial and hand and finger signing motions of a deaf person; and
- (2) converting the observed motions into digital identifiers.

Limitation (1) was added by the First Amendment. Limitation (2) was found

in the originally filed claim 1 in the form of "digitizing."

15. In the First Amendment at page 6, Appellant argued the following as to the amended claims:

The independent claims have also been amended to clarify the unique operation and structure of the present invention. More particularly, each of the independent claims clearly defines the first step of the method or one component of the apparatus as visually observing the facial, finger and hand motion of the deaf person and converting those signing motions into digital identifiers which are then translated into words and phrases.

The argument directly above addressed Finding of Fact 14 limitations (1) and (2) found in Appellant's amended claim 1.

16. In the First Amendment at page 7, Appellant further argued the following as to the amended claims:

Because of the technology employed by the Applicant in the novel method, the full range of signing motions can be observed, including hand motion, finger motion including interdigitation, body motion, lip motion and facial motion, all of which are used in ASL

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[American Sign Language]. None of the prior art can approach the apparatus and method of the present invention from the standpoint of recognition of all these forms of signing activity.

The argument directly above again addressed Finding of Fact 14 limitation (1).

17. On November 25, 1998, the Examiner entered a Final Office Action ("Final Action").

18. Amended claims 1-32 were rejected on various grounds.

19. Claims 1, 3, 5-10, 12, 14, 16-17, 19-23, 26, and 28-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakiyama and Abe, U.S. 5,544,050 (which is prior art under 35 U.S.C. § 102(b)).

20. Claims 2, 4, 11, 13, 15, 18, 24-25, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakiyama, Abe, and Wycherlay.

21. The Examiner also cited Abe (U.S. 5,473,705), Sako (U.S. 5,689,575), White (U.S. 5,734,794), Slager (U.S. 5,313,522), and Church (U.S. 5,283,833).

22. On February 3, 1999, the Examiner conducted an interview with Appellant's representative. The Examiner entered an Interview Summary into the record stating:

It was agreed that the prior art do not show or fairly suggest conversion of observed facial, hand and finger motions to digital identifiers which are then translated into words and phrases.

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The summary directly above addressed Finding of Fact 14 limitations (1) and (2) found in Appellant's amended claim 1.

23. On February 23, 1999, Appellant filed a Second Amendment ("the Second Amendment") responding to the Examiner's Final Office Action.

24. The Second Amendment similarly amended independent claims 1, 12, and 26. Amended claim 1 is reproduced below (matter underlined added by the Second Amendment):

1. An electronic communications system for the deaf comprising:

(a) a video apparatus for visually observing the images of facial and hand and finger signing motions of a deaf person and converting the observed signing motions into digital identifiers;

(b) means for translating said digital identifiers of said observed signing motions into words and phrases;

(c) means for outputting said words and phrases generated by the visual observation of said signing motions in a comprehensible form to another person;

(d) a receiver for receiving spoken words and phrases of another person and transmitting them;

(e) means for translating said spoken words and phrases into a visual form which may be observed by the deaf person; and

(f) means for outputting said visual form of said spoken words and phrases on said video apparatus for viewing by the deaf person.

25. After entry of the Second Amendment, the application claims were 1-32.

26. In the Second Amendment, Appellant presented extensive arguments with respect to the patentability of amended claim 1.

27. In the Second Amendment at pages 2-3, Appellant argued the following as to the amended claims:

Initially, Applicant's attorney wishes to thank Examiner Woo for her courtesy in granting a recent interview during which there were discussed the importance of recording and factoring facial motion and expression into the translation of the deaf person's input as pointed out in the specification at various points and in detail at pages 21-22. Also discussed were the differences between the novel method and apparatus of the present invention and the methods and apparatus of the prior art. Of particular significance is the fact that the method and apparatus of the present invention are able to process not only visual images of the hand and finger motions of a deaf person but also the facial expressions and motions since these are commonly used by deaf persons to convey emotion and to modify the content reflected merely by finger and hand motions. This is certainly not disclosed or suggested by any of the prior art patents and publications.

The argument directly above addressed Finding of Fact 14 limitation (1) found in Appellant's amended claim 1.

28. In the Second Amendment at pages 3-5, Appellant argued the following as to the amended claims:

Certainly nothing in Sakiyama et al discloses or suggests the present invention wherein a video camera captures information concerning facial motions and expressions as well as motion of fingers and hands to produce a composite of information which is converted into digital data subsequently converted to speech.

...
[As to Abe, U.S. 5,544,050,] [t]here is nothing which would suggest the very complex procedures required to observe such [facial] motions and expressions and convert them into digital data which can be processed with the data concerning finger and hand motion.

...
[Wycherley et al] certainly do not deal with the problem of recognition and conversion of facial motion and expression.

...
Abe et al Patent No. 5,473,705 ... [has] absolutely no suggestion of coupling hand and finger motion with facial motion and expression.

...
Sako et al ... do not disclose any method to integrate such facial expression data with data reflected by finger and hand motion with or without digitized gloves.

...
White ... certainly does not teach utilizing video observation of facial expression and motion and conversion into a neural network system to synthesize speech.

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Slager . . . does not attempt to correlate facial expression and motion with finger and hand motion as utilized in conventional sign language.

The arguments above addressed Finding of Fact 14 limitations (1) and (2) found in Appellant's amended claim 1.

29. On March 16, 1999, a Notice of Allowability was mailed which stated that pending claims 1-32 were allowed.

30. U.S. Patent 5,982,853 issued November 9, 1999, based on the original application and contained claims 1-32.

C. Prosecution of reissue application

31. Appellant filed reissue application 09/603,247 on June 23, 2000, seeking to reissue U.S. Patent 5,982,853.

32. Appellant presented original patent claims 1-32 along with new reissue application claims 33-46 for consideration.

33. Ultimately, reissue claims 33-38 and 40-45 were rejected.

34. Reissue application claims 33-38 and 40-45 are before the Board in the appeal.

35. A copy of the claims 33-38 and 40-45 under appeal is set forth in the Claim Appendix of Appellant's Brief.

D. Examiner's Rejection under 35 U.S.C. § 251

36. The Examiner has rejected reissue application claim 33 under 35 U.S.C. § 251 maintaining that the claims seek to "recapture" subject

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matter surrendered in obtaining allowance of the claims which appear in the patent sought to be reissued.

37. The Examiner based the rejection of claim 33 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 102(b) over the Kurokawa article and rejections under 35 U.S.C. § 103(a) over the Kurokawa and Rogers articles and the Abramatic patent, Appellant made one *significant* amendment to originally filed claim 1:

(1) Appellant amended rejected independent claim 1 to add the requirement that the signing motions be “images of facial and hand and finger;” amended original application claim 1 ultimately became patent claim 1.

The Examiner also based the rejection on the grounds that when faced with the rejections, Appellant made two *insignificant* amendments to originally filed claim 1:

(2) Appellant amended rejected independent claim 1 to restate the originally claimed digitizing of observed signing motions as “converting the observed motions into digital identifiers.”

(3) Appellant amended rejected independent claim 1 to make explicit the inherent original requirement that said words and phrases of step (c) are those “generated by the visual observation.”

38. Additionally, the Examiner based the rejection of claim 33 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 102(b) over the Kurokawa article and rejections under 35 U.S.C. § 103(a) over the Kurokawa and Rogers articles and the Abramatic patent,

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Appellant made *significant* arguments with respect to amended claim 1 (Supplemental Answer 5:5-11). (See also the Findings of Fact 14-16 *supra* with respect to Appellant's arguments regarding claim limitations (1) and (2).)

39. Finally, the Examiner based the rejection of claim 33 on the grounds that when faced in the original application with final rejections under 35 U.S.C. § 103(a) over the Sakiyama, Abe, and Wycherlay patents, Appellant made extensive *significant* arguments with respect to amended claim 1 (Supplemental Answer 5:5-11). (See also the Findings of Fact 22 and 27-28 *supra* with respect to Appellant's arguments regarding claim limitations (1) and (2).)

40. The Examiner reasoned as follows (Supplemental Answer 5:2-11):

The limitations omitted in the reissue claim 33 were added to the original application claim 1 for the purpose of making the claim allowable over a rejection made in the application (see pages 6-8 of the Amendment filed April 1, 1998). Moreover, the omitted limitations were repeatedly argued in the original application as defining over the prior art rejection (see pages 6-8 of the Amendment filed April 1, 1998, the Interview Summary of a personal interview conducted on February 3, 1999, and pages 2-6 of the Amendment filed February 23, 1999). These repeated arguments constitute an admission by Appellant that the limitations were necessary to overcome the prior art. Thus, the omitted limitations relate to subject matter previously surrendered in the original application.

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41. The record supports the Examiner's findings with respect to what limitations do not appear in reissue application claim 33 which were present in claim 1 of the original application, as allowed.

E. Examiner's Rejection under 35 U.S.C. § 102 and 103

42. The Examiner has rejected reissue application claims 33, 35-36, 38, 40, and 42-44 under 35 U.S.C. § 102(e) as being anticipated by Sakiyama (Supplemental Answer 5-7).

43. The Examiner has rejected reissue claims 34, 37, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Sakiyama and Wycherley (Supplemental Answer 7-8).

44. The Examiner has rejected reissue claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Sakiyama and King (Supplemental Answer 8).

IV. DISCUSSION – REJECTION UNDER 35 U.S.C. § 251

A. Recapture Principles

(1)

The statute

The reissue statute expressly permits a patentee to correct an error thus permitting patentee to obtain reissue claims broader than the originally issued patent claims at any time within two (2) years from the date the original patent issues. More particularly, 35 U.S.C. § 251, ¶¶ 1 and 4, provide in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

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(2)
*Recapture is not an error
within the meaning of 35 U.S.C. § 251*

What has become known as the “recapture rule,” prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

If a patentee attempts to “recapture” what the patentee previously surrendered in order to obtain allowance of original patent claims, that “deliberate withdrawal or amendment ... cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the [subject] matter withdrawn.” *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993), quoting from *Haliczer v. United States*, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966).³ See also *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998).

³ *Haliczer* is binding precedent. See *South Corp. v. United States*, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982) (in banc) (decisions of the former U.S. Court of Customs and Patent Appeals and former U.S. Court of Claims decisions are binding precedent).

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(3)
In re Clement

The Federal Circuit's opinion in *Clement* discusses a three-step test for analyzing recapture.

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims. The Federal Circuit reasoned that a reissue application claim deleting a limitation or element from a patent claim is broader as to that limitation's or element's aspect. *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter. *Clement*, 131 F.3d at 1468-69, 45 USPQ2d at 1164. In this respect, review of arguments and/or amendments during the prosecution history of the application, which matured into the patent sought to be reissued, is appropriate. In reviewing the prosecution history, the Federal Circuit observed that "[d]eliberately canceling or amending a claim in an effort to overcome a [prior art] reference strongly suggests that the Appellant admits that the scope of the claim before the cancellation or amendment is unpatentable." *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1164.

Step 3 is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim. *Id.* at 1469, 45 USPQ2d at 1164. The following principles were articulated in *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165:

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Substep (1): if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim;

Substep (2): if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible;

Substep (3): if the reissue claim is broader in some aspects, but narrower in others, then:

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

(4)

North American Container

In *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005), the Federal Circuit had occasion to further address Substep (3)(a) of *Clement*.

North American Container involved a reissue patent, which had been held invalid by the U.S. District Court for the Northern District of Texas. The district court bottomed its invalidity holding based on a violation of the recapture rule. During prosecution of an application for patent, an Examiner rejected the claims over a combination of two prior art references:

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Dechenne and Jakobsen. To overcome the rejection, *North American Container* limited its application claims by specifying that a shape of “inner walls” of a base of a container was “generally convex.” *North American Container* convinced the Examiner that the shape of the base, as amended, defined over “both the Dechenne patent, wherein the corresponding wall portions 3 are *slightly concave* ... and the Jakobsen patent, wherein the entire re-entrant portion is clearly *concave in its entirety*.” *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d at 1340, 75 USPQ2d at 1549. After a patent issued containing the amended claims, *North American Container* filed a reissue application seeking reissue claims in which (1) the language “inner wall portions are generally convex” was eliminated, but (2) the language “wherein the diameter of said re-entrant portion is in the range of 5% to 30% of the overall diameter of said side wall” was added. Thus, the claim sought to be reissued was broader in some aspects and narrower in other aspects.

The Federal Circuit, applying the *Clement* three-step test, held that the reissue claims were broader in scope than the originally-issued claims in that they no longer require the “inner walls” to be “generally convex.” The Federal Circuit further found that the broadened aspect (i.e., the broadened limitation) “relate[d] to subject matter that was surrendered during prosecution of the original-filed claims.” *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d at 1350, 75 USPQ2d at 1557. The Federal Circuit observed “the reissue claims were not narrowed with respect

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to the ‘inner wall’ limitation, thus avoiding the recapture rule.” The Federal Circuit stated:

[t]hat the reissue claims, looked at as a whole, may be of “intermediate scope” is irrelevant. . . . [T]he recapture rule is applied on a limitation-by-limitation basis, and ... [North American Container’s] deletion of the “generally convex” limitation clearly broadened the “inner wall” limitation.

Id. at 1350, 75 USPQ2d at 1557. Thus, the Federal Circuit in *North American Container* further refined Substep (3)(a) of *Clement*: “broader in an aspect germane to a prior art rejection” means broader with respect to a *specific* limitation (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and (2) eliminated in the reissue application claims.

(5)
Ex parte Eggert

The opinion in *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003), issued as a precedential opinion, is also part of the recapture precedent applicable to proceedings before the United States Patent & Trademark Office (USPTO). *Eggert* was entered on May 29, 2003, prior to the Federal Circuit’s *North American Container* decision. In *Eggert*, a majority stated that “[i]n our view, the surrendered subject matter is the outer circle of Drawing 1 [the rejected claim prior to the amendment that resulted in the claim being issued] because it is the subject matter appellants conceded was unpatentable.” *Eggert*, 67 USPQ2d at 1717. The majority further held that “in our view” subject matter narrower than the rejected claim but broader

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than the patented claim is not barred by the recapture rule. *Id.* 67 USPQ2d at 1717. The majority explained that if the finally rejected claim was ABC and the patent claim was ABCDEF, there would be recapture for ABC or anything broader than ABC, but not for claims directed to ABCX, ABCD_{Br}, ABCEF, or A_{Br}BCDEF, because those claims would be narrower than the finally rejected claim ABC. *Eggert*, 67 USPQ2d at 1718. In its opinion, the majority recognized that the Federal Circuit had held that “the mere presence of narrowing limitations in the reissue claim is not necessarily sufficient to save the reissue claim from the recapture rule.” *Eggert*, 67 USPQ at 1729.

Board of Patent Appeals and Interferences Standard Operating Procedure 2 (Revision 6) (August 10, 2005) mandates that a published precedential opinion of the Board is binding on all judges of the Board *unless* the views expressed in an opinion in support of the decision, among a number of things, are inconsistent with a decision of the Federal Circuit. In our view, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*.

The *Eggert* majority’s analysis is believed to be consistent with *North American Container* in that the majority applied the three-step framework analysis set forth in applicable Federal Circuit opinions, *e.g.*, (1) *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001); (2) *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 and (3) *Hester*, 142 F.3d at 1481, 46 USPQ2d at 1648-49. However, the *Eggert* majority also held that the surrendered subject matter was the rejected claim

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only rather than the amended portion of the issued claim. *Eggert*, 67 USPQ2d at 1717. At a similar point in the recapture analysis, *North American Container* has clarified the application of the three-step framework analysis. *North American Container* holds that the “inner walls” limitation (a portion of the issued claim that was added to the rejected claim by amendment) was “subject matter that was surrendered during prosecution of the original-filed claims.” *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d at 1350, 75 USPQ2d at 1557.

It is believed that the Substep (3)(a) rationale of the *Eggert* majority (1) is not consistent with the rationale of the Federal Circuit in *North American Container* and (2) should no longer be followed or be applicable to proceedings before the USPTO.

(6)

What subject matter is surrendered?

In a case involving Substep (3)(a) of Step 3 of *Clement*, what is the subject matter surrendered?

Is it

- (1) the subject matter of an application claim which was amended or canceled or
- (2) the subject matter of an application claim which was amended or canceled *and*, on a limitation-by-limitation basis, the territory falling between the scope of

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- (a) the application claim which was canceled or amended and
- (b) the patent claim which was ultimately issued?

We believe *North American Container* stands for the proposition that it is (2) and not (1). Accordingly, we hold that it is (2).

(7)
Clement principles are not per se rules

Our reading of our appellate reviewing court's recapture opinions, as a whole, suggests that the *Clement* steps should not be viewed as per se rules. For example, we note the following in *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1164:

Although the recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984), "the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available," *Ball [Corp. v. United States]* 729 F.2d at 1436, 221 USPQ at 294. Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. *See Mentor [Corp. v. Coloplast, Inc.]*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball*, 729 F.2d at 1438, 221 USPQ at 296; *Seattle Box Co.*, 731 F.2d at 826, 221 USPQ at 574 (declining to apply the recapture rule in the absence of

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evidence that the applicant's "amendment ... was in any sense an admission that the scope of [the] claim was not patentable"); *Haliczer [v. United States]*, 356 F.2d at 545, 148 USPQ at 569 (acquiescence in the rejection and acceptance of a patent whose claims include the limitation added by the applicant to distinguish the claims from the prior art shows intentional withdrawal of subject matter); *In re Willingham*, 282 F.2d 353, 354, 357, 127 USPQ 211, 213, 215 (CCPA 1960) (no intent to surrender where the applicant canceled and replaced a claim without an intervening action by the examiner). Amending a claim "by the inclusion of an additional limitation [has] exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation." *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956). [Footnote and citations to the CCPA reports omitted.]

(8)

Allocation of burden of proof

What is the proper allocation of the burden of proof in ex parte examination?

For reasons that follow, we hold that an Examiner has the burden of making out a prima facie case of recapture. The Examiner can make out a prima facie case of recapture by establishing that the claims sought to be reissued fall within Substeps (1) or 3(a) of Step 3 of *Clement*.

For reasons that follow, we also hold that once a prima facie case of recapture is established, the burden of persuasion then shifts to the Appellant to establish that the *prosecution history* of the application, which matured

into the patent sought to be reissued, establishes that a surrender of subject matter did not occur (or that the reissue claims are materially narrowed).

As will become apparent, our rationale parallels the practice in determining whether subject matter is surrendered when a doctrine of equivalents analysis occurs in infringement cases.

(9)

Burden of proof analysis

Our analysis begins with an observation made by our appellate reviewing court in *Hester*, 142 F.3d at 1481-82, 46 USPQ2d at 1649:

[A]s recognized in *Ball*, the recapture rule is based on principles of equity⁴ and therefore embodies the notion of estoppel. 729 F.2d at 1439, 221 USPQ at 296. Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, [520 U.S. 17, 33,] 117 S. Ct. 1040, 1051[, 41 USPQ2d 1865, 1873] (1997). Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability. *See id.*

⁴ The reissue statute has been characterized as being remedial in nature, based on fundamental principles of equity and fairness and should be construed liberally. *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (in banc); *In re Willingham*, 282 F.2d 353, 354-55, 127 USPQ 211, 214 (CCPA 1960). Nevertheless, fairness to the public must also be considered. As stated in *Mentor*, "the reissue statement cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so." *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525.

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Hester argues that an analogy cannot be made with prosecution history estoppel because the reissue procedure and prosecution history estoppel are the antithesis of one another--reissue allows an expansion of patent rights whereas prosecution history estoppel is limiting. However, *Hester's* argument is unpersuasive. The analogy is not to the broadening aspect of reissues. Rather, the analogy is with the recapture rule, which restricts the permissible range of expansion through reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.

This court earlier concluded that prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can arise by way of amendments to avoid prior art. *See, e.g., Texas Instruments, Inc. v. International Trade Comm'n*, 988 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993).

See also Judge Michel's opinion concurring-in-part and dissenting-in-part in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 602, 56 USPQ2d 1865, 1899 (Fed. Cir. 2000) (*Festo I*), *vacated and remanded*,

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535 U.S. 722, 122 S. Ct. 1831, 62 USPQ2d 1705 (2002) (Festo II)⁵ (Michel, J.):

[T]he law of prosecution history estoppel has developed with equal applicability to reissue patents and original patents whose claims were amended during prosecution. By at least 1879, the Supreme Court recognized that the process of obtaining a reissue patent precluded the patentee from recapturing that which he had disclaimed (i.e., surrendered), through the reissuance process.

(10)

Relevance of prosecution history

“Surrendered subject matter” is defined in connection with prosecution history estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, , 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 USPQ2d 1705, 1710-11 (2002) (Festo II):

The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes. When, however, the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter that should be

⁵ The “Festo” convention used in this opinion is:

Festo I is the original in banc decision of the Federal Circuit.

Festo II is the decision of the Supreme Court.

Festo III is the decision of the Federal Circuit on remand.

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deemed equivalent to the literal claims of the issued patent. On the contrary, “[b]y the amendment [the patentee] recognized and emphasized the difference between the two phrases[,] ... and [t]he difference which [the patentee] thus disclaimed must be regarded as material.” *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-137, 62 S. Ct. 513, [518-19] [52 USPQ 275, 279-80] (1942).

Festo II goes on to comment, 535 U.S. at 737-41, 122 S. Ct. at 1840-42, 62 USPQ2d at 1712-14:

[Prosecution history estoppel’s] reach requires an examination of the subject matter surrendered by the narrowing amendment. [A] complete bar [would avoid] this inquiry by establishing a *per se* rule; but that approach is inconsistent with the purpose of applying the estoppel in the first place—to hold the inventor to the representations made during the application process and to the inferences that *may reasonably* be drawn from the amendment (emphasis added).

*
*
*

A patentee’s decision to narrow his claims through amendment *may be presumed to be a general disclaimer of the territory between the original claim and the amended claim.* *Exhibit Supply*, 315 U.S., at 136-137, 62 S. Ct. 513 (“By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference”). There are some cases, however, where the amendment *cannot reasonably be viewed as surrendering* a particular equivalent.

The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases *the patentee can overcome the presumption* that prosecution history estoppel bars a finding of equivalence (emphasis added).

When the patentee has chosen to narrow a claim, *courts may presume* the amended text was composed with awareness of this rule and that the territory surrendered is not an equivalent of the territory claimed. In those instances, however, *the patentee still might rebut the presumption* that estoppel bars a claim of equivalence. The patentee must show that at the time of the amendment one skilled in the art *could not reasonably* be expected to have drafted a claim that would have literally encompassed the alleged equivalent (emphasis added).

The same policy considerations that prevent a patentee from urging equivalents within what the Supreme Court refers to as “surrendered territory” should prima facie prohibit the patentee from being able to claim subject matter within the surrendered territory in reissue. Accordingly, the “surrendered subject matter” that may not be recaptured through reissue should be *presumed* to include subject matter broader than the patent claims in a manner directly related to (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and (2) limitations argued to overcome a patentability

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rejection without amendment of a claim. These presumptions are believed to place practical and workable burdens on Examiners and Appellant.

(11)

Admissible evidence in rebuttal showing

As in the case of surrender when applying the doctrine of equivalents, a reissue Appellant should have an opportunity to rebut any prima facie case made by an Examiner.

What evidence may an Appellant rely on to rebut any prima facie case of recapture?

We hold that the admissible rebuttal evidence generally should be limited to (1) the prosecution history of the application which matured into the patent sought to be reissued and (2) showings related to what was known by a person having ordinary skill in the art at the time an amendment was made. Nevertheless, we will not attempt to divine, at this time, all evidence that might be relevant. As with other issues that come before the USPTO, such as obviousness and enablement, the evidence to be presented will vary on a case-by-case basis, as will the analysis of that evidence.

“It is clear that in determining whether ‘surrender’ of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent.” *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006). Thus, we also hold that an Appellant must show that at the time the amendment was made, an “objective observer” could not

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reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered (or that an “objective observer” would view the reissue claims as materially narrowed). The showing required to be made by Appellant is consistent with the public notice function of claims. Nevertheless, some limited extrinsic evidence may be relevant. However, extrinsic evidence unavailable to an “objective observer” at the time of the amendment is not relevant to showing that an “objective observer” could not reasonably have viewed the subject matter as having been surrendered. Limiting the nature of the admissible evidence is believed to be consistent with the Federal Circuit’s decision on remand following *Festo II*. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 344 F.3d 1359, 1367, 68 USPQ2d 1321, 1326 (Fed. Cir. 2003) (*Festo III*).

On remand, the Federal Circuit notes (*Id.* at 1367-70, 68 USPQ2d at 1326-29):

[W]e reinstate our earlier holding that a patentee’s rebuttal of the *Warner-Jenkinson* presumption is restricted to the evidence in the prosecution history record. *Festo* [I], 234 F.3d at 586 & n.6; *see also Pioneer Magnetics*, 330 F.3d at 1356 (stating that only the prosecution history record may be considered in determining whether a patentee has overcome the *Warner-Jenkinson* presumption, so as not to undermine the public notice function served by that record). If the patentee successfully establishes that the amendment was not for a reason of patentability, then prosecution history estoppel does not apply.

. . . By its very nature, objective unforeseeability depends on underlying factual issues relating to, for example, the state of the art and the understanding of a hypothetical person of ordinary skill in the art at the time of the amendment. Therefore, in determining whether an alleged equivalent would have been unforeseeable, a district court may hear expert testimony and consider other extrinsic evidence relating to the relevant factual inquiries.

. . . As we have held in the *Warner-Jenkinson* context, that reason should be discernible from the prosecution history record, if the public notice function of a patent and its prosecution history is to have significance. *See id.* at 1356 (“Only the public record of the patent prosecution, the prosecution history, can be a basis for [the reason for the amendment to the claim]. Otherwise, the public notice function of the patent record would be undermined.”); *Festo* [I], 234 F.3d at 586 (“In order to give due deference to public notice considerations under the *Warner-Jenkinson* framework, a patent holder seeking to establish the reason for an amendment must base his arguments solely upon the public record of the patent’s prosecution, i.e., the patent’s prosecution history. To hold otherwise--that is, to allow a patent holder to rely on evidence not in the public record to establish a reason for an amendment--would undermine the public notice function of the patent record.”). Moreover, whether an amendment was merely tangential to an alleged equivalent necessarily requires focus on the context in which the amendment was made; hence the resort to the prosecution history. Thus, whether the patentee has established a merely tangential reason for a narrowing amendment is for the court to determine from the prosecution history record without the introduction of additional evidence, except, when necessary, testimony from those skilled in the art as to the interpretation of that record.

. . . When at all possible, determination of the third rebuttal criterion should also be limited to the prosecution history

record. . . . We need not decide now what evidence outside the prosecution history record, if any, should be considered in determining if a patentee has met its burden under this third rebuttal criterion.

We interpret Festo III to generally, perhaps effectively, limit the admissible rebuttal evidence to the prosecution history record and extrinsic evidence related to the knowledge of the hypothetical person of ordinary skill in the art at the time of the amendment. Admitting evidence not available to the public, such as an affidavit of an attorney giving mental impressions from the attorney who made the amendment, would undermine the public notice function of the patent and its prosecution history.

(12)

Materially Narrowed in Overlooked Aspects

When reissue claims are narrower than the patent claims with respect to features other than the surrender generating feature, then the reissue claims may be materially narrowed relative to the claims prosecuted and issued in the patent, thereby avoiding the recapture rule.

The Federal Circuit in *North American Container* characterized the second and third steps in applying the recapture rule as determining “whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution” and “whether the reissued claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.” *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d at 1349, 75 USPQ2d at

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1556 (emphases added), citing for authority *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600. The language “materially narrowed in other respects” relates for comparison back to the earlier recited “broader aspects of the reissued claims” (i.e., surrendered subject matter). Thus, by using the phrase “in other respects” to modify “materially narrowed,” the court makes clear that reissue claims will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter. This plain language in *North American Container* indicates that the recapture rule is avoided if the added limitations are materially narrowing in respects other than the broader aspects relating to surrendered subject matter.

In *Pannu*, the Federal Circuit described the second step of the recapture rule analysis as determining “whether the broader aspects of the reissued claim related to surrendered subject matter.” *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600 (quoting *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164). With regard to the third step, the court stated: “Finally, the Court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.” *Id.* at 1371, 59 USPQ2d at 1600 (emphases added), citing for authority *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. As in *North American Container*, the language “materially narrowed in other respects” relates for comparison back to the earlier recited “broader aspects of the reissued claim” (i.e., surrendered subject matter). Again, modification of “materially narrowed” with the phrase “in other respects” clarifies that

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reissue claims will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter.

Similarly, in *Hester Indus.*, the Federal Circuit determined that “surrendered subject matter - i.e., cooking other than solely with steam and with at least two sources of steam – has crept into the reissue claims [because] [t]he asserted reissue claims are unmistakably broader in these respects.” *Hester Indus.*, 142 F.3d at 1482, 46 USPQ2d at 1649.

Immediately after making this determination, the court then stated: “Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects.” *Id.* at 1482, 46 USPQ2d at 1649 (emphases added). Yet again, the language “materially narrowed in other respects” relates for comparison back to the earlier recited language “[t]he asserted reissue claims are unmistakably broader in these respects.” It follows that *Hester Indus.* also makes clear that a reissue claim will avoid the recapture rule if materially narrowed in respects other than the broader aspects relating to surrendered subject matter.

There is a reason the Federal Circuit has repeatedly assessed recapture rule avoidance in terms of whether the reissue claims were materially narrowed in respects other than the broader aspects relating to surrendered subject matter. The reason involves the purpose served by permitting the recapture rule to be avoided under certain circumstances. This purpose is described in *Hester Indus.* as follows:

[T]his principle [i.e., avoidance of the recapture rule], in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

142 F.3d at 1482-83, 46 USPQ2d at 1649-50.

As explained in *Hester Indus.*, the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention. Because recapture rule avoidance requires the reissue claim to be materially narrowed in an overlooked aspect of the invention, this material narrowing must be in respects other than the broader aspects relating to surrendered subject matter. Stated differently, a material narrowing in an overlooked aspect cannot possibly relate to surrendered subject matter since this subject matter, having been claimed and then surrendered during original prosecution, could not have been overlooked.

In *Pannu*, the Federal Circuit stated that “[t]he narrowing aspect of the claim on reissue ... was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means [, and] [t]herefore, the reissued claims were not narrowed in any material respect compared with their broadening.” *Pannu*, 258 F.3d at 1372, 59 USPQ2d at 1600-01.

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If read in a vacuum, this statement might appear to support a contrary result to our analysis. However, the court's opinion in general and this statement in particular must be read, not in a vacuum but, in light of the facts of the case on appeal.

The reissued claim in *Pannu* was narrowed by requiring the snag resistant means to be "at least three times greater" than the width of the haptics and by requiring the snag resistant means to be "substantially coplanar" with the haptics. *Pannu*, 258 F.3d at 1372, 59 USPQ2d at 1600. As revealed in the underlying District Court decision, these same or similar limitations were present in claims throughout prosecution of the original patent application. *Pannu v. Storz Instruments, Inc.*, 106 F. Supp. 2d 1304, 1308 (S.D. Fla. 2000). For this reason, the District Court held that the recapture rule had not been avoided because the narrowing limitations were not overlooked aspects of the invention and did not materially narrow the claim. *Id.* at 1308-09, citing for authority *Hester Indus.*, 142 F.3d at 1483, 45 USPQ2d at 1650 and *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1165.

This factual background more fully illuminates the Federal Circuit's determination in *Pannu* that the reissued claims were not narrowed in any material respect compared with their broadening. This determination is not based on the fact that the narrowing limitations of the reissue claims were unrelated to their broadening. Rather, it is based on the fact that these same or similar limitations had been prosecuted in the original patent application and therefore were not overlooked aspects of the invention and did not materially narrow the reissue claims.

The reissue claims in *Clement* were both broader and narrower in aspects germane to a prior art rejection. *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. However, the narrower limitation recited in the *Clement* reissue claims (“at least 59 ISO in the final pulp”; *see* clause (e) of reissue claim 49), also was recited in the patent claims (*see* clause (f) of patent claim 1). *Clement*, 131 F.3d at 1470, 1474, 45 USPQ2d at 1165, 1169. Therefore, the narrowing limitation of *Clement*, like *Pannu*, was not overlooked during original prosecution and did not materially narrow the reissue claim.

Finally, in *Mentor*, each of the limitations added to the reissue claims were thoroughly analyzed and determined to not be materially narrowing because the same or similar features were in the patent claims or the prior art. *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525-26. It follows that the reissue claims of *Mentor*, like those of *Pannu* and *Clement*, failed to avoid the recapture rule because they had been broadened to include surrendered subject matter but had not been narrowed in any material respect.

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

- (1) which had not been claimed and thus were overlooked during prosecution of the original patent application;⁶ and

⁶ For a patent containing only apparatus claims, it might be argued that reissue method claims cannot involve surrendered subject matter where no method claim was ever presented during prosecution of the patent.

(2) which patentably distinguish over the prior art.

(13)
Non-relevance of “intervening rights”

We have not overlooked a possibility that an argument might be made that the so-called intervening rights provision relating to reissues makes jurisprudence on the doctrine of equivalents presumption inapplicable to reissue recapture rules. Our answer as to the argument is similar to the answer given by the Federal Circuit in *Hester* with respect to whether the doctrine of equivalents surrender principles have any applicability to reissue surrender principles. *Hester* squarely held that they do. Moreover, mixing “intervening rights” with “surrender” is like mixing apples with oranges or putting the cart before the horse. A patentee seeking a reissue claim which is barred by recapture is not entitled to a reissue patent under 35 U.S.C. § 251. If there is no reissue patent, there can be no intervening rights.

(14)
Public Notice

We believe that any recapture analysis must be bottomed principally on a “public notice” analysis which can occur only after a record becomes “fixed.” In the case of a patent, the “claims” and the “prosecution history”

However, surrender is not avoided merely by categorizing a claimed invention as a method rather than an apparatus. It is the scope of a claimed invention, not its categorization, which determines whether surrendered subject matter has crept into a reissue claim.

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become fixed at the time the patent is issued--not during “fluid” patent prosecution where claims and arguments can change depending on the circumstances, *e.g.*, prior art applied and amendments to claims. It is from a fixed perspective that the public (not the patentee) must make an analysis of what the patentee surrendered during prosecution. Moreover, an Appellant (not the public) controls what amendments and arguments are presented during prosecution. When an amendment or argument is presented, it is the Appellant that should be in the best position to analyze what subject matter (*i.e.*, territory to use the Supreme Court’s language) is being surrendered (or explain why the reissue claims are materially narrowed).

Our belief is supported by what appears to be dicta in *MBO Laboratories, Inc. v. Becton, Dickinson & Company*, No. 2006-1062, slip. op. at 12-13 (Fed. Cir. Jan. 24, 2007):

The recapture rule is a limitation on the ability of patentees to broaden their patents after issuance.
Section 251 is “remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.” However, the remedial function of the statute is limited. Material which has been surrendered in order to obtain issuance cannot be reclaimed via Section 251: . . . It is critical to avoid allowing surrendered matter to creep back into the issued patent, since competitors and the public are on notice of the surrender and may have come to rely on the consequent limitations on claim scope. . . . (“[T]he recapture rule ... ensur[es] the ability of the public to rely on a patent’s public record.”). The public’s reliance interest provides a justification for the recapture rule that is independent of the likelihood that the surrendered territory was already covered by prior art

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or otherwise unpatentable. The recapture rule thus serves the same policy as does the doctrine of prosecution history estoppel: both operate, albeit in different ways, to prevent a patentee from encroaching back into territory that had previously been committed to the public. (citations omitted.)

B. § 251- The Examiner's Prima Facie Case

Our Findings of Fact 37-40 set out the basis upon which the Examiner originally made a recapture rejection in the Final Office Action. As noted in Finding of Fact 41, the record supports the Examiner's findings.

Basically, in the application which matured into the patent now sought to be reissued, the Examiner rejected originally filed independent claim 1 over the prior art. Appellant proceeded to re-write application claim 1 by adding new limitations. Amended application claim 1 ultimately issued as patent claim 1.

The Examiner made five points in Findings of Fact 37-40:

- (1) when faced with a rejection in the original application, Appellant made a *significant* amendment (See Finding of Fact 37 (1));
- (2) when faced with a rejection in the original application, Appellant made two *insignificant* amendments (See Finding of Fact 37 (2) and (3));
- (3) when faced with a rejection in the original application, Appellant made *significant* arguments (See Finding of Fact 38 and Findings of Fact 14-16);

- (4) when faced with a final rejection in the original application, Appellant made extensive *significant* arguments (See Finding of Fact 39 and Findings of Fact 22, 27, and 28);
- (5) reissue claim 33 is broader than the original patent claims with respect to almost all the limitations added and arguments made to overcome the rejection (See Findings of Fact 37-40).

The Examiner's accurate factual analysis demonstrates that the Examiner has made out a prima facie case of recapture consistent with the test set forth in *Clement* and amplified in *Hester*.

Further, we hold that with respect to the Examiner's rejection, the burden of persuasion now shifts to the Appellant to establish that the *prosecution history* of the application, which matured into the patent sought to be reissued, establishes that a surrender of subject matter did not occur or that the reissued claims were materially narrowed.

C. § 251 - Appellant's Response

(1)

Per Se Rule and Ex Parte Eggert

With respect to independent claim 33, Appellant argues at page 7 of the Brief, that the Board should not impose a per se recapture rule. We agree. See our discussion at Section IV. A. *supra*.

Appellant also argues at page 7, that *Ex Parte Eggert*, 67 USPQ2d 1716 (BPAI 2003), is controlling. We disagree. See our discussion at

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Section IV. A. (5) *supra*. The rationale of *Eggert* is not consistent with the rationale of the Federal Circuit in *North American Container* and should no longer be followed or be applicable to proceedings before the USPTO.

Appellant then argues that the analysis should begin with the rejected claims not the allowed claims. We disagree. *Clement*, which is controlling, holds that the analysis begins with a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims. *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164.

(2)

Appellant's Patentability Arguments in the Original Application

Appellant argues without further explanation at pages 7-8 of the Brief, that “[a]s for the Examiner’s contention about the arguments presented [in the original application] by Appellant in support of the amended claims which were allowed, it is submitted that these arguments do not act as a surrender of the subject matter now being claimed in claims 33-45.” We disagree.

We conclude that “an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent.” *Kim v. ConAgra Foods, Inc.*, 465 F.3d at 1323, 80 USPQ2d at 1502. We also conclude that Appellant has not shown that at the time the amendment or argument was made, an “objective observer” could not reasonably have viewed the subject matter broader than the argued limitation(s) as having been surrendered.

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Appellant also argues at pages 11-12 of the Brief that “the arguments pointed to by the Examiner in the final rejection do not operate as a surrender of the claimed subject matter” because they “are merely a regurgitation of the added claim limitations which led to allowance and issuance of the patent. We disagree.

First, the fact that the arguments pointed to by the Examiner *regurgitate* the added claim limitations does not help Appellant rebut the presumed surrender because a surrender generating argument would usually point to some limitation of the claim. Regurgitation is not precluded as a method of pointing out the surrender generating limitation of the claim. Second, we reiterate that Appellant has not shown that at the time the amendment or argument was made, an “objective observer” could not reasonably have viewed the subject matter broader than the argued limitation(s) as having been surrendered.

(3)

Surrendered Subject Matter

Appellant argues at pages 8-9 of the Brief that only the claim 1 as originally filed and rejected “is the subject matter which was surrendered by Appellant during the prosecution.” We disagree. See our discussion at Section IV. A. (6) *supra*. We conclude the surrendered subject matter also includes, on a limitation-by-limitation basis, the territory falling between the scope of (a) the application claim which was canceled or amended and (b) the patent claim which was ultimately issued.

(4)

Comparing Reissue Claim 33 to Originally Filed Claim 1

With respect to independent claim 33, Appellant goes on at pages 9-12 of the Brief to compare reissue claim 33 to originally filed claim 1. We find this comparison insufficient for the reasons discussed *supra*. Appellant does not address the limitations added to originally filed claim 1 and/or argued to support patentability.

Further, we find errors in Appellant's comparison. First, at page 10, line 23, Appellant compares a limitation of reissue claim 33 to "(b)" of original claim 1. Clearly (e) rather than (b) is the appropriate limitation for the comparison. This error is harmless as the limitation of reissue claim 33 is narrower than (e). Second, at page 11, lines 4-20, Appellant argues:

Claim 33 next calls for "said device utilized by said hearing impaired person including means for receiving words and phrases from the hearing impaired person." This limitation substantively embraces the subject matter of limitation (a) in rejected claim 1. Appellant acknowledges that this limitation omits the phrase "digitizing the signing motions of a deaf person" and thus appears to be broader; however, such a perception as explained below is incorrect.

Claim 33 next calls for "said transforming means converting said and phrases from the hearing person into a form which may be presented to a hearing person." It is submitted that this limitation is narrower than "digitizing" portion of limitation (a) in rejected claim 1 since it requires that the words and phrases be converted into a form which may be presented to a hearing person.

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It is also submitted that this limitation captures the essence of the “digitizing” portion of limitation (a).

We see nothing in this argument that persuades us that the limitation in reissue claim 33 is narrower than the “digitizing” in originally filed claim 1. To the contrary, we conclude that claim 33 is broader as to this limitation. Third, we find “said transforming means converting said words and phrases from the hearing impaired person into a form which may be presented to a hearing person” is also broader than limitation (b) of originally filed of claim 1 to which it should be compared (under Appellant’s theory of recapture).

We conclude that Appellant has not rebutted the Examiner’s prima facie showing of recapture based on his comparison.

(5)

Surrendered Subject Matter

Appellant argues at page 12 of the Brief that recapture is avoided because:

It is submitted that there was never a rejection of a claim directed to the novel and unobvious features of claim 33, namely the device used by the hearing impaired person to view a textual display also including means for receiving words from the hearing impaired person, because no claim of the same scope was ever presented.

We disagree. We conclude Appellant is arguing that the reissue claim is materially narrowed with respect to an overlooked aspect. As discussed at Section IV. A. (12) *supra*, a reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention (1) which

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had not been claimed and thus were overlooked during prosecution of the original patent application; and (2) which patentably distinguish over the prior art.

Originally filed claim 10 (now patent claim 10) recites in part:

The electronic communications system in accordance with claim 1 wherein said video apparatus includes a display screen to provide an output of said spoken words and phrases as signing motions on said display screen for viewing by the deaf person

See also originally filed and patented claim 31. Originally filed claim 10 places a display screen in the video apparatus and demonstrates that a device to view and receive words from the user (as signing motions) was prosecuted in the original application. Thus, we conclude this limitation is not an aspect overlooked in the original prosecution. Since this conclusion is dispositive, so we need not reach a conclusion here on whether this feature patentably distinguishes over the prior art.

We conclude that with respect to this argument Appellant has not rebutted the Examiner's prima facie showing of recapture.

(6)

New Ground of Rejection of Dependent Claims 34-43 and 45

With respect to dependent claims 34-45, Appellant argues at page 8 of the Brief, that "it is submitted that the rejection under 35 U.S.C. 251 is flawed because the Examiner has only analyzed the subject matter of independent claim 33 and has not conducted any analysis of rejected dependent claims 34-45." The Examiner subsequently withdrew the

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rejection of claims 34-45 under 35 U.S.C. § 251. We disagree with Appellant's argument.

We turn to the Examiner's rejection, at pages 2-3 of the Final Rejection entered January 27, 2004. The Examiner's rejection focuses on the extensively argued "facial" limitation added to originally filed claim 1 by amendment. The Examiner then states:

Therefore, the subject matter previously surrendered in the application for the patent is a system without the following limitations: a video apparatus for visually observing the images of *facial* and hand and finger signing motions and converting the observed signing motions into digital identifiers, a means for translating said digital identifiers of said observed signing motions into words and phrases, and a means for outputting said words and phrases generated by the visual observation of said signing motions.

Finally, the Examiner states:

The limitations omitted in the newly added claims 33-45 of the reissue are the same limitations added by the applicant for the purpose of obtaining allowance in the original prosecution, as clearly stated in applicant's arguments during the original prosecution

We find that contrary to Appellant's argument, the Examiner has provided an analysis of claims 34-45. Given the facts of the case before us, we conclude that this analysis is sufficient to raise a presumption that subject matter broader than the "facial" and other argued limitations were surrendered. We find nothing in the in Appellant's repeated statements to the effect that dependent claims 34-45 are narrower than independent claim

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33, which rebuts this presumption. (Br. 12-14). Dependent claims are by definition narrower than the claims from which they depend.

37 C.F.R. § 1.75(c).

However, we do note that claim 44 includes the “facial” limitation and that the Examiner’s analysis is in error on its face as to claim 44.

Therefore, we reinstate the rejection of claims 34-43 and 45 under 35 U.S.C. § 251 using our authority under 37 C.F.R. § 41.50(b) because we find an analysis in the record, we conclude that analysis is sufficient to raise a presumption of surrender, and we conclude Appellant has not rebutted the presumption.

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

V. DISCUSSION – REJECTIONS UNDER 35 U.S.C. § 102 and §103

A. Principles

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

B. Examiner's § 102 Rejection

The Examiner has rejected reissue application claims 33, 35-36, 38, 40, and 42-44 under 35 U.S.C. § 102(e) as being anticipated by Sakiyama (Supplemental Examiner's Answer 5-7, and 10-11). With respect to the construction of claim 33, the Examiner concludes:

However, [c]laim 33 does not require that the camera (means for receiving) form a part of the monitor (means for outputting). Rather, claim 33 recites a device utilized by a hearing impaired person which includes a means for outputting and a means for receiving (claim 33, lines 9-13).

The Examiner then finds:

In Sakiyama, the general apparatus depicted in Figure 22 can be considered as the "device utilized by a hearing impaired person" and includes an aurally handicapped person side display unit 36, monitor 7, mouse 38, video camera 21, etc. The examiner contends that this apparatus is clearly a device which includes a

means for outputting textual material for display (the apparatus includes a monitor 7 which displays translated spoken words and phrases in the form of text; see Figure 23). The apparatus (which includes a monitor 7) depicted in Figure 22 also includes a means for receiving words and phrases from the hearing impaired person (the apparatus includes a video camera 21 which receives words and phrases from the aurally handicapped person by capturing signing motions; col. 16, lines 26-28).

C. § 102 - Appellant's Response

The Appellant argues that Sakiyama does not teach a device for outputting and receiving as required by claim 33. Rather, Sakiyama discloses a system and not a device (Br. 16). We agree.

A “device” is “a thing made for a particular purpose” and a “system” is “an assemblage or combination of things or parts forming a complex or unitary whole.”⁷ Sakiyama describes a system (not a device). Therefore, the Appellant has shown that the Examiner erred in rejecting claims 33, 35-36, 38, 40, and 42-44 under 35 U.S.C. § 102(e).

D. Examiner's § 103 Rejections and Appellant's Response

The Examiner rejected reissue claims 34, 37, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Sakiyama and Wycherley;

⁷ Dictionary.com Unabridged (v 1.1) based on the Random House Unabridged Dictionary, © Random House, Inc. 2006.

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and claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Sakiyama and King (Supplemental Examiner's Answer 7-8).

As the Appellant correctly points out (Br. 18, and Reply Br. 7.), neither the Wycherley or King patents in combination with the Sakiyama patent cure the deficiencies of the Sakiyama patent noted above with respect to claim 33. Therefore, the Appellant has shown that the Examiner erred in rejecting claims 34, 37, 41, and 45.

VI. CONCLUSIONS OF LAW

(1) Appellant has established that the Examiner erred in rejecting 33, 35-36, 38, 40, and 42-44 under 35 U.S.C. § 102(e), and claims 34, 37, 41, and 45 under 35 U.S.C. § 103(a).

(2) Appellant has failed to establish that the Examiner erred in rejecting claim 33 under 35 U.S.C. § 251 based on recapture. Specifically:

(a) Appellant's arguments have not rebutted the presumption, upon which the Examiner's rejection is based, i.e., that at the time of the amendment an objective observer would reasonably have viewed the subject matter of the narrowing amendment and limitations argued in the parent as having been surrendered.

(b) Appellant's arguments have not established that the reissue claims are materially narrowed with respect to an overlooked aspect of the invention.

(3) Claims 33-43 and 45 are not patentable.

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(4) On the record before us, claim 44 has not been shown to be unpatentable.

VII. DECISION

Upon consideration of the record, and for the reasons given, we reverse the rejection of claims 33, 35-36, 38, 40, and 42-44 under 35 U.S.C. § 102(e); we reverse the rejection of claims 34, 37, 41, and 45 under 35 U.S.C. § 103(a); and we affirm the rejection of claim 33 under 35 U.S.C. § 251 based on recapture.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

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Blankenship, *Administrative Patent Judge*, concurring.

I agree with my colleagues that Appellant has established that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e) or § 103(a). With respect to the rejection of claim 33 under 35 U.S.C. § 251, I agree with the findings and analysis set forth above to the extent that, in view of the prosecution history, broader aspects of reissue claim 33 as compared to the patent claims relate to surrendered subject matter.

“Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim.” *In re Clement*, 131 F.3d 1464, 1469, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

When a reissue claim is broader than a canceled or amended claim in some aspects, but narrower in others, *Clement* instructs us how to determine whether the surrendered subject matter has crept into the reissue claim. The Federal Circuit in *Clement* referred to two earlier cases as examples of how the recapture rule relates to broad and narrow aspects of reissue claims as compared to claims in the original application.

In *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993), the issued claim was directed to a condom catheter, reciting an adhesive means that was transferred from an outer to an inner surface without turning the condom inside-out. In making amendments to the claim, the applicant argued that none of the applied references showed the transfer of adhesive from the outer surface to the inner surface as the sheath is rolled

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up and then unrolled. The reissue claim eliminated the limitation that adhesive was transferred from the outer to the inner layer, making the reissue claim broader than the canceled claim in this aspect. The reissue claim was also narrower than the canceled claim because it recited that the catheter included a thin, flexible cylindrical material rolled outwardly upon itself to form a single roll. Although the “flexible” and “single roll” limitations made the reissue claim narrower than both the canceled and issued claims, the reissue claim did not escape the recapture rule because the limitations did not “materially narrow the claim.” *In re Clement* at 1469-70, 45 USPQ2d at 1165. *See also Mentor Corp.* at 993, 995-97, 27 USPQ2d at 1523-26.

In *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984), the issued claim recited “a plurality of feedlines” and a “substantially cylindrical conductor.” The canceled claim recited “feed means includ[ing] at least one conductive lead” and a “substantially cylindrical conductor.” The prosecution history showed that the patentee added the “plurality of feedlines” limitation in an effort to overcome a prior art rejection, but the cylindrical configuration limitation was not added to overcome a prior art rejection nor argued to distinguish over a reference. The reissue claim included limitations not present in the canceled claims that related to the feed means element, but allowed for multiple feedlines. The reissue claim was narrower than the canceled claim with respect to the feed means aspect. The reissue claim deleted the cylindrical configuration limitation, which made the claim broader with respect to the configuration of

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the conductor. The reissue claim was allowed because the patentee “was not attempting to recapture surrendered subject matter.” *In re Clement* at 1470, 45 USPQ2d at 1165. *See also Ball Corp.* at 1432-33, 1437, 221 USPQ at 291-92, 295.

In both *Mentor* and *Ball*, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim⁸ in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. *Mentor* is an example of (3)(a); *Ball* is an example of (3)(b).

In re Clement at 1470, 45 USPQ2d at 1165 (footnote added).

⁸ The “canceled or amended claim” is the claim that was canceled or amended. “Once we determine that an applicant has *surrendered the subject matter* of the *canceled or amended claim*, we then determine whether the surrendered subject matter has crept into the reissue claim” (emphasis added). *In re Clement* at 1469, 45 USPQ2d at 1164. In *Clement*, the Federal Circuit compared the reissue claim with the corresponding application claim as it stood before the amendments added during prosecution. *See In re Clement* at 1470-71, 45 USPQ2d at 1165-66.

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In this case, original (application) claim 1 recited an electronic communication system for the deaf comprising “(a) a video apparatus for observing and digitizing the signing motions of a deaf person” In response to a rejection over the prior art, the “video apparatus” was limited to be a “video apparatus for visually observing the images of facial and hand finger signing motions of a deaf person and converting the observed singing motions into digital identifiers”

The corresponding limitation, if any, in reissue claim 33 for the earlier claimed “video apparatus” appears to be the recitation that the device utilized by the hearing impaired person includes “means for receiving words and phrases from the hearing impaired person”

The “means for receiving words and phrases” seems limited to a video camera or the structural equivalent of a video camera. All the embodiments described in the patent utilize at least one video camera for the purpose of receiving words and phrases from the hearing impaired person. *See, e.g.*, '853 patent at col. 5, l. 62 - col. 6, l. 29; col. 13, ll. 4-8. On the other hand, however, depending claim 35 of the reissue recites that the means “comprises a video camera for capturing signing motions generated by said

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hearing impaired person.” Original claim 1 required a video apparatus for observing the signing motions of a deaf person. Claim 35 of the reissue appears to be *as broad as* original claim 1 in an aspect germane to a prior art rejection. Base claim 33 must be *broader than* original claim 1 in an aspect germane to a prior art rejection.

Reissue claim 33 may be narrower than original claim 1 in aspects unrelated to the rejection. However, the recapture rule, in accordance with above-quoted principle 3(a) identified in *Clement*, bars the claim. Claim 33 is properly rejected under 35 U.S.C. § 251, as are claims 34-43 and 45 in the new ground of rejection.

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